

76



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/669,088	09/23/2003	Udi Manber	121189	1874

26389 7590 04/17/2006

CHRISTENSEN, O'CONNOR, JOHNSON, KINDNESS, PLLC  
1420 FIFTH AVENUE  
SUITE 2800  
SEATTLE, WA 98101-2347

EXAMINER

LE, MIRANDA

ART UNIT PAPER NUMBER

2167

DATE MAILED: 04/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/669,088

Applicant(s)

MANBER ET AL.

Examiner

Miranda Le

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 January 1947.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/13/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Information Disclosure Statement***

1. Applicants' Information Disclosure Statement, filed 13 April 2004, has been received, entered into the record, and considered. See attached form PTO-1449.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless:

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10, 23-32, 33, 43-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (US Patent No. 6,694,331).

Lee anticipated independent claims 1, 33, 24 by the following:

**As to claims 1, 33,** Lee teaches a method for electronically searching a user-personalized library of content, comprising:

(a) receiving one or more search terms (i.e. keywords; text or graphics in select fields, col. 4, lines 18-19) from a user having an electronically-searchable personalized library of

Art Unit: 2167

content (i.e. workspace portfolio, col. 6, line 31), (col. 4, lines 7-29, col. 6, lines 18-31, col. 7, line 53 to col. 8, line 11);

(b) electronically searching the full text of the user's personalized library for pages of content (i.e. portions of each patent (i.e. col. 6, line 29) that match the search terms to produce search results (i.e. The results may include a list of intellectual property (e.g., issued patents) or other information corresponding to the search criteria or query developed by (or input to) SO server 30, col. 4, lines 31-34) (col. 4, line 49 to col. 5, line 55, col. 6, lines 18-34);

(c) providing the search results to the user (i.e. the search results are presented as an ordered list, col. 4, lines 52-53), (col. 4, line 49 to col. 5, line 55, col. 7, line 53 to col. 8, line 11);

(d) receiving a search result selection from the user (i.e. as well as view one or more portions or segments or information fields of different documents, col. 5, lines 1-3), (col. 4, line 49 to col. 5, line 55, col. 7, line 53 to col. 9, line 16); and

(e) providing to the user an image of a page (e.g., patent images, text, etc. at col. 7, line 33) of content in the user's personalized library based on the user's search result selection (col. 4, line 49 to col. 5, line 55, col. 7, line 53 to col. 9, line 16).

**As per claim 24**, Lee teaches a method for preparing a user-personalized library of content for electronic searching, comprising:

(a) acquiring a general library of content (i.e. intellectual property is stored in database 32 and/or in one or more remote database systems (e.g., database 39, at col. 3, line 36-39) that includes images and corresponding text of pages of content (i.e. including text and images, col. 3, line 46, document types such as PDF, RTF, TIF, HTML, col. 4, line 4), (col. 3, lines 36-61, col. 3, line 61 to col. 4, line 6);

(b) preparing a page image database (i.e. workstation portfolio, col. 6, line 31) comprised of the images (i.e. and images, col. 3, line 46) of pages of content (col. 3, lines 37-60, col. 6, line 5 to col. 7, line 41);

(c) preparing a text searchable database (i.e. Class search module 310 may retrieve the additional search criteria from stored search criteria (e.g., imported from a user's workspace), col. 7, lines 59-61) comprised of the corresponding text of pages of content (col. 7, line 53 to col. 9, line 16); and

(d) receiving from a user a selection of content in the general library (i.e. select documents, search results, and/or search criteria may be stored in a user's workspace in a manner similar to that described above in connection with search engine 304, col. 8, lines 8-11) to form a user-personalized library of content that the user can electronically search using the text searchable database (col. 4, line 49 to col. 5, line 55, col. 7, line 53 to col. 9, line 16).

**As per claim 2**, Lee teaches prior to receiving one or more search terms from the user, establishing an electronically-searchable library of content that includes a page image database and a text searchable database, which library of content is personalized by the user to consist of content selected by the user (col. 4, lines 7-29, col. 7, line 53 to col. 9, line 16).

**As per claim 3**, Lee teaches the method of claim 2, in which the library of content is personalized by manual selection of content by the user (col. 4, lines 7-29, col. 6, line 5 to col. 7, line 41, col. 7, line 53 to col. 9, line 16).

**As per claim 4**, Lee teaches the library of content is automatically personalized based on user selection of content for review or purchase (col. 4, line 49 to col. 5, line 55, col. 6, lines 5-56).

**As per claim 5**, Lee teaches the user-personalized library of content is established at the time the user conducts the search (col. 4, lines 7-29, col. 6, line 5 to col. 7, line 41, col. 7, line 53 to col. 9, line 16).

**As per claim 6**, Lee teaches the user's personalized library of content is derived from a publicly-accessible general library of content (col. 3, lines 36-61, col. 4, line 49 to col. 5, line 55).

**As per claim 7**, Lee teaches providing the search results to the user includes providing a list of content having pages with text that matches the search terms (col. 4, lines 49-58).

**As to claims 8, 44**, Lee teaches ranking the content in the list of content according to a predetermined criterion (col. 4, line 49 to col. 5, line 55).

**As per claim 9**, Lee teaches providing to the user an image of a page of content includes retrieving the page image from a database of page images stored in computer memory (col. 7, lines 11-41).

**As per claim 10**, Lee teaches the user's personalized library is defined after electronically searching a general library of content using the search terms, the user's personalized library being fully contained within the general library of content and defining the scope of search results provided to the user (col. 7, lines 11-41, col. 7, line 41, col. 7, line 53 to col. 9, line 16).

**As to claims 23, 43**, Lee teaches a non-text object in the user's personalized library is made searchable by including text data related to the object in the electronic search (col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).

**As per claim 25**, Lee teaches defining classes of content and assigning content in the user's personalized library to one or more of the classes (col. 5, line 33 to col. 6, line 34, col. 11, lines 17-39).

**As per claim 26**, Lee teaches limiting a search of the user's personalized library to content in a specified class (col. 5, line 33 to col. 6, line 34, col. 6, line 57 to col. 7, line 10)

**As per claim 27**, Lee teaches the personalized library of content is comprised of content selected by a group of persons constituting a user, the method further comprising enabling persons in the group to conduct searches of the personalized library of content (col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).

**As per claim 28**, Lee teaches the method of claim 24, in which the user's selection of content in the general library is received based on manual selection by the user (col. 5, line 33 to col. 6, line 34).

**As per claim 29**, Lee teaches the user's selection of content in the general library is automatically received based on a selection of content by the user for review or purchase (col. 5, line 33 to col. 6, line 34, col. 11, line 62 to col. 12, line 29).

**As per claim 30**, Lee teaches storing the user-personalized library of content in a memory for later retrieval by the user (col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).

**As per claim 31**, Lee teaches enabling the user to store and retrieve multiple user-personalized libraries (col. 5, line 33 to col. 6, line 34, col. 11, lines 17-62).

As per claim 32, Lee teaches the user's selection of content in the general library is aided by providing the user with a list of content determined to be related to a subject content (col. 5, line 33 to col. 6, line 34, col. 9, line 39 to col. 10, line 60).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14-22, 34-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US Patent No. 6,694,331), in view of McCollom et al. (US Patent No. 6,925,444).

As to claims 14, 34, Lee does not expressly teach using one or more access rules to limit an amount of content in one or more page images provided to the user.

However, McCollom teaches this limitation at col. 5, line 39 to col. 6, line 11, col. 10, lines 11-38.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lee with the teachings of McCollom to include using one or more access rules to limit an amount of content in one or more page images provided to the user



Art Unit: 2167

because it would provide an user interface which allow the users to create a purchase list by receiving advertisement data on the consumer device, selecting an item desired for purchase, identifying the purchase list for the item to be saved, creating the purchase list if the purchase list identified does not exist, and saving the item to the identified purchase list.

**As to claims 15, 35,** McCollonm teaches the access rules define an aggregate amount of content that can be provided to the user over a time frame at col. 18, line 65 to col. 19, line 19.

**As to claims 16, 36,** McCollonm teaches the access rules define a percentage of content that can be provided to the user over a time frame at col. 9, lines 9-34.

**As to claims 17, 37,** McCollonm teaches the access rules define the amount of content that can be provided to the user based on content-specific information at col. 17, lines 18-67.

**As to claims 18, 38,** McCollonm teaches the access rules define the amount of content that can be provided to the user based on user ownership of the content at col. 5, line 9 to col. 6, line 11, col. 22, lines 9-57.

**As to claims 19, 39,** McCollonm teaches reviewing purchase records to validate user ownership of the content at col. 5, line 39 to col. 6, line 11, col. 10, lines 11-38, col. 22, lines 9-57.

**As to claims 20, 40,** McCollonm teaches different access rules apply based on the location of the user at col. 16, lines 37 col. 17, line 11, col. 22, lines 9-57.

**As to claims 21, 41,** McCollonm teaches different access rules apply based on the time the content is to be provided to the user at col. 9, lines 9-34, col. 17, lines 18-67.

As to **claims 22, 42**, McCollonm teaches the access rules define the amount of content that can be provided to the user based on an identification of the user at col. 16, lines 37 to col. 17, line 11.

6. Claims 11-13, 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (US Patent No. 6,694,331), in view of Evans et al. (US Patent No. 6,532,461).

As to **claims 11, 45**, Lee does not expressly teach the following limitations. However, Evans teaches:

(a) providing location information to the user that identifies the location of the search terms in the page image (col. 5, lines 46-67); and

(b) instructing an electronic application of highlight to the page image by the user in accordance with the location information to highlight the search terms in the page image (col. 5, lines 46-67).

Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Lee with the teachings of Evans to include the claimed limitations because it would provide an regions in the document image that correspond to words in the document text are determined.

As to **claims 13, 47**, Evans teaches the electronic application of highlight to the page image comprises placement of a visual indicator next to the search terms at col. 5, lines 46-67.

Art Unit: 2167

*Conclusion*

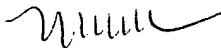
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene., can be reached on (571) 272-4107. The fax number to this Art Unit is 571-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Miranda Le

March 15, 2006

